

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: Q79956

Christophe PREGUICA, et al.

Appln. No.: 10/787,145

Group Art Unit: 2144

Confirmation No.: 4599

Examiner: Shirley X. ZHANG

Filed: February 27, 2004

For: ADDRESS SEQUENCING IN A DOMAIN NAME SERVER

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated July 7, 2009. Entry of this Reply Brief is respectfully requested.

Table of Contents

STATUS OF CLAIMS	2
GROUND OF REJECTION TO BE REVIEWED ON APPEAL	3
ARGUMENT	4
CONCLUSION	9

STATUS OF CLAIMS

Claims 1-4 are all the claims pending in the application and are the claims on appeal herein.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. Claim 1 is rejected under 35 U.S.C. § 112, 2nd paragraph as having insufficient antecedent basis.

B. Claims 1-4 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over IETF Draft by Draves titled "Default Address Selection for IPv6" (hereinafter "Draves"), in view of U.S. Patent No. 6,748,434 to Kavanagh, and the e-mail message posted by Keith Moore on the IETF IPv6 Operations (v6ops) Working Group's discussion board on November 18, 2002 (hereinafter "Moore").

ARGUMENT

Appellant stands by the arguments set forth in the Appeal Brief as filed on April 9, 2009. Additionally, Appellant provides the following remarks in response to the Examiner's Answer of July 7, 2009.

A. Rejection of Claim 1 under 35 U.S.C. § 112, 2nd paragraph.

Claim 1 is rejected under 35 U.S.C. § 112, 2nd paragraph on the grounds that the term "the sender" has insufficient antecedent basis. As noted in the Appeal Brief, Appellant submitted that claim 1 is not indefinite since one of ordinary skill in the art could reasonably ascertain the scope regarding the sender.

In the Examiner's Answer, the Examiner merely asserted that claim 1 does not comply with 35 U.S.C. § 112, 2nd paragraph since the claim element "the sender" clearly lacks explicit antecedent basis regardless of whether one of ordinary skill in the art could reasonably ascertain the scope of the claim element. That is to say, the Examiner has introduced into the Patent Laws a new requirement. Under the Examiner's view, the second paragraph of 35 U.S.C. § 112 requires perfect antecedent basis without respect to whether the claims particularly point out and distinctly claim the subject matter of the invention.

The Examiner's position is erroneous, not founded in the statute, not supported by the rules, and not even adopted in the MPEP. The meaning of the offending claim language is apparent; the clarity is unchallenged; the usage is in harmony with its ordinary meaning; no term of degree is used; no variability in the claim language is introduced; no reasonable apprehension of an improper interpretation has been raised.

Although the lack of clarity issue could arise when a claim refers to “said” but contains no earlier recitation or limitation, the determination as to indefiniteness of a claim is not merely based on whether a claimed element has an explicit antecedent basis (MPEP 2173.05(e)). Instead, the failure to provide explicit antecedent basis for terms does not render a claim indefinite if the scope of a claim would be reasonably ascertainable by those skilled in the art. The MPEP 2173.05(e) further clarifies that an inherent component of an element of a claim has antecedent basis in the recitation of the element itself. In claim 1, one of ordinary skill in the art could clearly recognize the sender of the said request as referring to an entity sending the request and thus could reasonably ascertain the scope of the claim. In addition, a sender sending the request is inherently present since the receipt of the received request necessarily requires a sender that sent the request.

In addition, the usage of the definite article instead of the indefinite article makes more sense, idiomatically speaking, to the reader’s internal ears. That is to say, the introduction of “to receive a request” in line 3 of the claim sets up in the reader’s mind that the request to be received has a sender. The recitation of “means for returning to the sender,” when introduced, is therefore read in the context of a received request, a context in which the reader would find “a sender” to be confusing, almost implying that a received request could have more than one sender.

Far be it for Appellant to charge that the Examiner is woodenly requiring perfect (albeit imperfectly clear) antecedent basis out of a lack of appreciation for the subtleties of the English language, or perhaps out of a “safe” approach to §112 required by the examining group, but to

the disinterested observer it is difficult to conceive of other reasonable explanations. What other conclusion can be drawn after noting that (1) Appellant's recitation of the claim language makes more sense to the average reader than the alternative recitation required by the Examiner; (2) Appellant's recitation of the claim language (namely, an inherent aspect of a previously stated element) is expressly recognized in the MPEP as being appropriate (2173.05(e)); and (3) the case law as well supports Appellant's position.

In a time when the amendment of a claim element for reasons of patentability can cause Appellant to "surrender" claim scope and lose protection under the doctrine of equivalents, it is impractical for the USPTO to use §112 to force Appellant to modify the claims to suit the Examiner's taste when the claims as presented are clear enough to support examination on the merits and are not indefinite. The statute does not require a particular degree of "definiteness" and therefore Appellant respectfully submits that, so long as the claim 1 is definite enough, the claim cannot be properly rejected under §112, second paragraph. The rejection is thus legally erroneous and should be reversed. Such a reversal is respectfully requested.

In addition, Appellant urges that it would not be a waste of resources to inquire as to the source of the Examiner's misapprehension of the requirements of §112. For the examining group to permit the adjudication of this kind of disagreement between applicant and examiner to reach a full appeal may indicate that there is a fundamental misunderstanding of the statute within a group larger than just the Examiner.

**B. Claim Rejections under 35 U.S.C. § 103 (a) based on Draves in view of
Kavanagh and Moore**

In the April 9, 2009 Appeal Brief, Appellant pointed out that Draves does not teach or suggest “address sequencing means” of claim 1, and Kavanagh does not make up for the deficiencies of Draves.

In the Examiner’s Answer, the Examiner correctly stated “Draves did not explicitly disclose that the addressing sequencing can be done by a DNS server.” The Examiner further mentioned that a node receives a list of IP addresses from the domain name server (DNS) and sequences and selects an IP address from the list (Examiner’s Answer at page 12). Appellant agrees with the Examiner’s clarification that Draves explicitly states that the sorting of the destination addresses is performed by a node, not by the DNS server, which Appellant argued in the Appeal Brief (Appeal Brief at page 13).

With regard to the secondary reference Kavanagh, the Examiner asserted that Kavanagh supplements Draves’ disclosure by disclosing that an adaptive DNS selection server can be used for sequencing the IP addresses corresponding to a domain name and returning the sequence list (Examiner Answer at page 13). Appellant, however, respectfully disagrees with the Examiner’s assertion as set forth in the Appeal Brief (pages 14-16). Kavanagh teaches that a network link monitor monitors validity of the nodes such as current statuses of GGSN interfaces and reports the statuses to an adaptive DNS selection server, and the adaptive DNS selection server may return to a user valid addresses of GGSN interfaces that are currently available in the network (col. 9, lines 9-15 and 29-36). Kavanagh, in fact, **does not teach** or suggest “sequencing a

plurality of IP v6 addresses associated with said second network element,” as recited in claim 1 because “a plurality of addresses” that the DNS returns to a node are not associated with “a specific one network element” in Kavanagh, unlike the claimed invention.

In the Examiner’s Answer, the Examiner opined that one of ordinary skill in the art would have been motivated to combine Draves and Kavanagh in view of Moore. Appellant submits that Moore would not have provided one of ordinary skill in the art with any motivation to combine Draves and Kavanagh as set forth in the Appeal Brief.

The Examiner additionally contended that even without relying on Moore one of ordinary skill in the art would still be motivated to combine Draves and Kavanagh on the grounds that both Draves and Kavanagh disclose (1) using DNS to solve a network node’s queries for IP addresses, and (2) the scenario of having multiple IP addresses associated with a domain name (Examiner’s Answer at page 15) by citing Draves (page 2; Introduction,) and Kavanagh (column 2, line 2 (an adaptive domain name server (DNS)); line 9 (key IP addresses); line 25(a given fixed number of addresses to return)).

It should be noted, however, that Draves mainly discusses “Address Selection Algorithm” and explicitly discloses that the node, not the DNS, sorts the destination addresses, i.e., by applying a destination address selection algorithm which takes a list of destination addresses and sorts the addresses to produce an ordering list (see, Abstract; 1. Introduction; 6. Destination Address Selection). More specifically, as described in the portion of Draves (1. Introduction; page 2) that the Examiner relies on, the node receives a set of addresses for a given name from the DNS, and uses, for a destination selection, an application (a destination selection

algorithm) which decides which one use the first, and in what order to try others should the first one not be reachable. In view of these feature of Draves, one of ordinary skill in the art would not have been motivated to modify Draves by Kavanagh because the suggested combination would destroy the intent, purpose or function of the teachings of Draves.

In addition to the above, Appellant renews the arguments presented in the April 9, 2009 Appeal Brief.

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

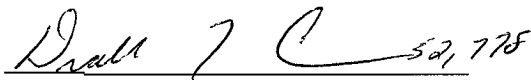
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